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10/071,957	02/07/2002	Stephen W. Edge	01P24279US01	3682

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EXAMINER

WIDHALM, ANGELA M

ART UNIT PAPER NUMBER

2152

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/071,957	EDGE, STEPHEN W.	
	Examiner	Art Unit	
	Angela Widhalm	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 February 2002.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The claims 1-28 are pending in this application. This is a non-final office action in response to Application Number 10/071,957 filed on 07 February 2002.

### ***Specification***

2. The abstract of the disclosure is objected to because the first sentence restates information already described in the title. Correction is required. See MPEP § 608.01(b).

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The claimed invention relates to a method, home privacy server, and medium for storing instructions (collectively referred to as "system") for sending a location request, communicating with a home location privacy server, determining the requested location, and transmitting a response to the location request in accordance with privacy information. In which in the same field of endeavor, the applied references teach the same.

***Claim Objections***

5. Claim 12 is objected to because of the following informality: Applicant claims associating the home database server with "GMS." Examiner assumes Applicant means to claim "GSM" and so performed a prior art search using "GSM" rather than "GMS." Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 6, 8, 14, 17, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 1, 6, 8, 14, 17, and 28 claim a privacy server network address. When reading Applicant's *Specification*, Examiner identifies two possible interpretations of a privacy server network address based on the description given on page 7, lines 8-16.

The first possibility interprets the privacy server network address as any network address as long as it is not the actual network address associated with the communication network that is currently providing service to the subscriber.

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The second possibility interprets the privacy server network address as any network address associated with the communication network that is currently providing service to the subscriber as long as the privacy server network address is not the actual network address that is currently providing service to the subscriber.

Since language of the claim could be interpreted in more than one way, it renders uncertainty of metes and bounds of the claim. Therefore, claims 1, 6, 8, 14, 17, and 28 are rejected under 35 USC §112 as being indefinite (see MPEP 2173.02). For purposes of examining this application, Examiner assumes the first interpretation.

9. The claimed invention relates to a method, home privacy server, and medium for storing instructions (collectively referred to as "system") for sending a location request, communicating with a home location privacy server, determining the requested location, and transmitting a response to the location request in accordance with privacy information. In which in the same field of endeavor, the applied references teach the same.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 1-6, 11, 14-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) (U.S. Application 10/071,957), further in view of McDowell (U.S. Patent Publication 2002/0035605).

12. Regarding claim 1, AAPA disclosed a system for facilitating subscriber location in accordance with privacy information, comprising:

receiving a network address request at a home database server, the network address request being associated with a subscriber device (see figure 1, *Specification* page 2 lines 13-19); and

providing a network address in response to the network address request (see figure 1, *Specification* page 2 lines 20-24).

AAPA did not explicitly disclose sending a privacy server network address.

However, in an analogous art, McDowell disclosed a WAP Gateway 136 that queried a Location Proxy Server 114 for location information. The Location Proxy Server 114 then communicated with a privacy database 119 for authorization to send location information to the WAP Gateway 136 (see paragraph 83). The Location Proxy Server operated as a privacy server when querying the privacy database 119. A privacy server network address was sent in order for communication between the WAP Gateway 136, the Location Proxy Server 114, and the privacy database 119 to occur.

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It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teachings of McDowell into the teachings of AAPA to increase a subscriber's level of privacy when requesting and transmitting location information. Incorporating a privacy database or server as suggested by McDowell into the existing system as admitted by Applicant would ensure that only those entities considered "friendly" would receive the requested location information.

13. Regarding claim 18, AAPA disclosed a system for facilitating subscriber location in accordance with privacy information, comprising:

receiving a location request, the location request being associated with a subscriber device (see figure 1, *Specification* page 2 lines 13-19);

providing the location information in response to the location request (see *Specification* page 2 line 31 – page 3 line 2).

AAPA did not explicitly disclose a home location privacy server or determining location information in accordance with privacy information associated with the subscriber device.

However, in an analogous art, McDowell disclosed a network gateway that included a location proxy module that maintained location data for the wireless subscribers (see paragraphs 37 and 48). The Location Proxy Server 114 receives a location request and is in communication with a privacy database 119 to verify that the subscriber has given

permission for a Web service to access the subscriber's location information (see paragraph 83).

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teachings of McDowell into the teachings of AAPA to increase a subscriber's level of privacy when requesting and transmitting location information. Incorporating a privacy server into the system would ensure that only those entities considered "friendly" would receive the requested location information.

14. Claim 28 includes the limitations of claims 1 and 18 and is rejected under the same prior art as claims 1 and 18.

15. Regarding claim 2, AAPA-McDowell disclosed wherein the network address request is associated with a location request from a client device (see AAPA *Specification* page 2 lines 1-6).

16. Regarding claim 3, AAPA-McDowell disclosed wherein the location request is associated with a geographic location of the subscriber device (see AAPA *Specification* page 2 lines 1-6).

17. Regarding claim 4, AAPA-McDowell disclosed wherein the subscriber device is associated with a wireless network (see AAPA *Specification* page 2 lines 23-24).



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18. Regarding claim 5, AAPA-McDowell disclosed the network address request is received from a gateway location server (see AAPA figure 1, *Specification* page 2 lines 13-19).

19. Regarding claim 6, AAPA-McDowell disclosed the invention substantially as discussed in the rejection of claim 1 above, including a network address to the gateway location server (see AAPA *Specification* page 2 lines 20-24).

20. Regarding claim 11, AAPA-McDowell disclosed the home database server comprises (i) a home location register (see McDowell paragraph 57).

21. Regarding claims 14, 17, 24, and 27, AAPA-McDowell disclosed the invention substantially as claimed as discussed in claim 1 and 18 above. Furthermore, AAPA-McDowell disclosed a computer system for the same operations, which inherently included a processor (i.e. CPU) (claims 14 and 24) and a storage device (claims 14 and 24) or medium (claims 17 and 27) (i.e. memory) in communication with said processor and storing instructions adapted to be executed by said processor to perform the method of claim 1 (claims 14 and 17) and claim 18 (claims 24 and 27).

22. Regarding claims 15 and 25, AAPA-McDowell disclosed wherein said storage device further stores a subscriber network database (claim 15: see McDowell paragraph 34; the presence module maintains data concerning the network presence of the

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wireless subscribers) or a subscriber privacy database (claim 25: see McDowell paragraph 35, figure 2 #119).

23. Regarding claims 16 and 26, AAPA-McDowell disclosed wherein said processor is further coupled to a communication device adapted to communicate with (ii) a gateway location server (see McDowell figure 2 #136, paragraph 83; it is inherent that a processor is included in PLIM system that communicates with the WAP Gateway 136).

24. Regarding claim 19, AAPA-McDowell disclosed wherein the location request is received from a client device via a gateway location server (see AAPA figure 1, *Specification* page 2 lines 1-12).

25. Regarding claim 20, AAPA-McDowell disclosed transmitting the location information to a client device via a gateway location server (see AAPA figure 1, *Specification* page 2 line 31 – page 3 line 2).

26. Regarding claim 21, AAPA-McDowell disclosed:  
retrieving privacy information associated with the subscriber device (see McDowell paragraph 38);  
evaluating the privacy information (see McDowell paragraph 38); and  
determining if the location information will be provided based on said evaluation (see McDowell paragraph 38).

27. Regarding claim 22, AAPA-McDowell disclosed wherein said evaluating is further based on (i) a client device associated with the location request (see McDowell paragraph 38).

28. Regarding claim 23, AAPA-McDowell disclosed:

transmitting a network address request to a home database server; (see AAPA figure 1, *Specification* page 2 lines 13-19)

receiving from the home database server a visited network address associated with the subscriber device; (see AAPA figure 1, *Specification* page 2 lines 20-24)

transmitting a location request to a visited network server via the visited network address (see AAPA figure 1, *Specification* page 2 lines 25-26); and

receiving the location information from the visited network server (see AAPA figure 1, *Specification* page 2 line 31 – page 3 line 2).

29. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell in view of AAPA as applied to claim 1 above, and further in view of Olsson (U.S. Patent Publication 2002/008968).

30. Regarding claim 12, McDowell in view of AAPA disclosed the limitations, substantially as claimed, as described in claim 11.

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McDowell in view of AAPA did not explicitly disclose wherein the home database server is associated with at least one of: (i) GSM, (ii) ANSI-41, (iii) 3GPP, and (iv) 3GPP2.

However, in an analogous art, Olsson disclosed a GSM Public Land Mobile Network (see paragraph 21).

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teachings of Olsson into the teachings of McDowell in view of AAPA to further specify the allowable types of wireless technologies used in McDowell's system for location-based services.

31. Regarding claim 13, AAPA-McDowell disclosed the invention substantially as discussed in the rejection of claim 1 above, including the home location privacy server associated with a mobile position center (see McDowell, paragraph 87).

AAPA-McDowell did not explicitly disclose using GSM, ANSI-41, 3GPP, or 3GPP2 technology.

However, in an analogous art, Olsson disclosed a GSM Public Land Mobile Network (see paragraph 21).

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It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teachings of Olsson into the teachings of McDowell in view of AAPA to further specify the allowable types of wireless technologies used in McDowell's system for location-based services.

32. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA-McDowell, as applied to claim 1 above, and further in view of Walsh (U.S. Patent 6,662,014).

33. Regarding claim 7, AAPA-McDowell disclosed the limitations, substantially as claimed, as described in claim 6.

AAPA-McDowell did not explicitly disclose determining an association between the gateway location and a home network, wherein said providing is only performed when the gateway location server is associated with the home network.

However, in an analogous art, Walsh disclosed determining whether the wireless communication device 102 is registered to operate with the location privacy manager 106 (see column 6 lines 53-57) and then only sending the location information once it is determined that the wireless communication device 102 is registered to operate with the location privacy manager 106 (see column 6 lines 58-62).

Registering a wireless communication device with a location privacy manager establishes an association between the two. The wireless communication device operates within a home network whether or not the wireless communication network is incorporated as a part of the home network, so then establishing an association with the wireless communication device also establishes an association with the home network. The wireless communication network includes a base station #300 (see figure 3 #300, column 5 lines 5-13) that operates as a gateway location. When the location privacy manager is an integral part of a wireless communication network (see column 3 lines 62-64), then registering the wireless communication device with the location privacy manager also establishes an association between the base station #300 and the wireless communication device.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teachings of Walsh into the teachings of AAPA-McDowell to increase a subscriber's level of privacy when requesting and transmitting a subscriber's location information. Only providing location information to a gateway associated with the home network would ensure that only those entities considered "friendly" would receive the requested location information (see Walsh, column 2 lines 10-14, line 59 – column 3 line 16).

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34. Regarding claim 8, AAPA-McDowell disclosed the invention substantially as described in the rejection of claim 1 above but did not explicitly disclose the privacy server network address is associated with a home location privacy server.

However, in the same field of endeavor, Walsh disclosed a privacy server network address associated with a home location privacy server (see column 6 lines 16-24; column 3 lines 28-37, 54-64).

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teachings of Walsh into the teachings of AAPA-McDowell to increase a subscriber's level of privacy when requesting and transmitting a subscriber's location information by enabling communication with the location privacy manager (see Walsh, column 3 lines 11-16).

35. Regarding claim 9, AAPA-McDowell-Walsh disclosed receiving a request from the location privacy manager (see Walsh, column 6 lines 50-57).

36. Regarding claim 10, AAPA-McDowell-Walsh disclosed transmitting the visited network address to the home location privacy server (see Walsh, column 3 lines 28-37, 54-64).

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela Widhalm whose telephone number is (571) 272-1035. The examiner can normally be reached M-F, 8:30 am - 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AW, 11/28/2005



**BUNJOB JAROENCHONWANIT**  
**PRIMARY EXAMINER**